UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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R2001-292

SEP 5 2001

In re

: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 C.F.R. § 10.7(c)

MEMORANDUM AND ORDER

petitions for regrading his answers to questions 21, 25 and 43 of the afternoon section of the Registration Examination held on October 18, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 68. On January 30, 2001, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under

35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the Official Gazette. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the

answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions.

Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has not been awarded any additional points. No credit has been awarded for afternoon questions 21, 25 and 43. Petitioner's arguments for these questions are addressed individually below.

Afternoon question 21 reads as follows:
21. You are prosecuting a patent application wherein an Office action has been issued rejecting the claims as being obvious over the prior art and objecting to the drawings as failing to illustrate an item that is fully described in the specification and included in a dependent claim. The examiner has required an amendment to Figure 1 to illustrate the item. In preparing a reply to the Office action, you identify several errors in Figure 2 that should also be corrected. Assuming that you make a amendment to the claims and develop persuasive arguments to overcome the obviousness rejection and that the examiner will not object to your desired changes to Figure 2, which of the following actions is likely to lead to the most favorable result?

(A) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. Submit a separate cover letter for replacement Figures 1 and 2 that incorporate the amendments to the drawings.

(B) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. In the Remarks portion of the reply, explain the proposed drawing changes and attach copies of Figures 1 and 2 with the changes marked in red for the examiner's review and approval.

(C) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. In a separate paper, explain the proposed drawing changes and attach copies of Figures 1 and 2 with the changes marked in red for the examiner's review and approval.

(D) Options (A), (B) and (C) are equally likely to lead to the most favorable result.

(E) Options (B) and (C) are equally likely to lead to the most favorable result.

The model answer is selection C.

(A) is not the best answer because drawing changes normally must be approved by the examiner before the application will be allowed. The examiner must give written approval for alterations or corrections before the drawing is corrected. MPEP § 608.02(q). (B) is not the best answer because any proposal by an applicant for amendment of the drawing to cure defects must be embodied in a separate letter to the draftsman. MPEP § 608.02(r). (D) is not the best answer because it incorporates (A) and (B), and (E) is not the best answer because it incorporates (B).

Petitioner argues that answer (E) is correct. Petitioner contends that answer (B) is also correct, which would make (E) the best answer. Petitioner argues that 37 CFR 1.121(3)(iii) does not require that applicant file a separate paper to submit drawing

changes because the rule uses "should," not "must," therefore both answers (B) and (C) would equally lead to a favorable result.

Petitioner's arguments have been fully considered but are not persuasive. The petitioner argues that nothing in the rules requires an amendment to the drawings be made in a separate paper. The MPEP clearly states that any proposal by an applicant for amendment of the drawing to cure defects must be embodied in a separate letter to the draftsman. (MPEP § 608.02(r)). The question is which of the answers below will lead to the most favorable result. Answer (C) is the best answer because it complies with the rules and the MPEP, while answer (B) might comply with the rule, it is not the best answer. Drawings must go to the draftsman for review, thus placing the drawings in a separate paper will facilitate their review and prosecution of the application. Accordingly, model answer (C) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 25 reads as follows:
25. Which of the following statements concerning reliance by an examiner on common knowledge in the art, in a rejection under 35 U.S.C. § 103 is correct?

I. Applicant can traverse an examiner's statement of common knowledge in the art, at any time during the prosecution of an application to properly rebut the statement.

II. An examiner's statement of common knowledge in the art is taken as admitted prior art, if applicant does not seasonably traverse the well known statement during examination.

III. If applicant rebuts an examiner's statement of common knowledge in the art in the next reply after the Office action in which the statement was made, the examiner can never provide a reference to support the statement of common knowledge in the next Office action and make the next Office action final.

(A) I
(B) II
(C) III
(D) I and II
(E) None of the above.

The model answer is selection (B).

MPEP § 2144.03. I is incorrect because an applicant must seasonably traverse the well-know statement or the object of the well-known statement is taken to be admitted prior art. In re Chevenard, 60 USPQ 239 (CCPA 1943). Therefore (A) and (D) are incorrect. III is incorrect because the action can potentially be made final. Therefore (C) is incorrect. (E) is incorrect because (B) is correct.

Petitioner argues that answer (D) is correct. Petitioner contends that answer I has ambiguous meaning and should also be accepted. Petitioner contends that since one is required to respond to every objection and rejection under the rules, "thus the phrase 'at any time during the prosecution' may refer to any time between receipt of the office action and the next response by the practitioner. . . ."

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that I is ambiguous and could mean any time between receipt of the office action and the next response by the practitioner, I clearly states "at any time during **the prosecution of the application**." Answer I permits the application to traverse beyond the next response. The correct answer limits applicant to timely responding to the "well-known" statement in the next response. Accordingly, model answer (B) is correct and petitioner's answer (D) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 43 reads as follows:
43. An article in a popular scientific journal, dated January 13, 1998, fully discloses and teaches how to make a "Smart Shoe" wireless telecommunications device. The article discloses a shoe having a dialer in a rubber sole of the shoe. The article does not teach or suggest using a metallic shoelace as an antenna or for any other purpose. Which of the following claims in an application filed January 20, 1999 is/are anticipated by the journal article, and is/are not likely to be properly rejected under 35 U.S.C. § 112, second paragraph as indefinite?

Claim 1. A telecommunications device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and optionally a metallic shoelace.

Claim 2. A telecommunication device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and a metallic shoelace.

Claim 3. A telecommunication device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and optionally a random access memory for storing telephone numbers.

(A) Claim 1.
(B) Claim 2.
(C) Claim 3.
(D) Claims 1 and 3.
(E) None of the above.

The model answer is selection (D).

MPEP § 2173.05(h). Ex Parte Cordova, 10 USPQ2d 1949 (Bd. Pat. App. & Inter. 1989) and 35 U.S.C. § 102(b). (B) is incorrect since the article does not disclose a metallic shoelace. Since the "optional" element does not have to be disclosed in a reference for the claim to be anticipated, claims 1 and 3 are each anticipated by the article. Thus, (A), (C), and (E) are incorrect.

Petitioner argues that answer (B) is correct. Petitioner contends that the wording of the question is ambiguous and could be interpreted to mean that the article does include a metallic shoelace and therefore answer (B) is correct.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the wording could mean the article does include a metallic shoelace, the wording clearly states: "The article does not teach or suggest using a metallic shoelace as an antenna or for **any** other purpose." The use of the word "any" excludes all purposes for the article mentioning a metallic shoelace. Additionally, if the article did teach the use of a metallic shoe lace as petitioner argues, then all of the claims would be anticipated by the article. Accordingly, model answer (D) is correct and petitioner's answer (B) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

ORDER

For the reasons given above, no point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 68. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy